

REMARKS

Claims 1-16, 18-29, and 32-38 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Specifically, the Examiner stated that the expression "fixedly attached" found in claims 1 and 26 is not supported in the specification. Applicants respectfully traverse this rejection.

As an initial matter, MPEP 2163 requires the Examiner to provide "reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed". The Office Action does not comply with this requirement. Instead, the Office Action merely provides a conclusory statement that the claim fails to comply with the written description.

The specification clearly provides the necessary support for the term. Paragraph [0043] points out that Figs. 9 through 14 show various manufacturing methods for affixing an elastic bumper to the corresponding plastic housing. Paragraph [0044] describes that the elastic bumper may be over-molded onto the plastic housing to mechanically interlock the elastic bumper to the plastic housing. Other means of mechanically interlocking are described. Paragraph [0045] describes an elastic bumper that is bonded to a plastic housing such that an interface of the bumper and plastic housing is completely melted together. Paragraph [0046] describes an elastic bumper affixed to a plastic housing by an adhesive. Paragraph [0049] describes an elastic bumper that may be formed from a liquid elastomeric material in which the plastic housing is dipped such that the plastic housing receives a layer of rubber material that either melts with or cures to an interface with the plastic housing.

MPEP 1302.01 also cautions that "exact terms need not be used *in haec verba* to satisfy the written description requirement of the first paragraph of 35 U.S.C. 112". *Eiselstein v. Frank*, 52 F.3d 1035, 1038, 34 USPQ2d 1467, 1470 (Fed. Cir. 1995); *In re Wertheim*, 541 F.2d 257, 265, 191 USPQ 90, 98 (CCPA 1976). See also 37 CFR 1.121(e) which merely requires *substantial* correspondence between the language of the claims and the language of the specification. One skilled in the art would understand that the above provides complete written description support for the phrase fixedly mounted. Therefore, the rejection should be withdrawn.

The same claims were also rejected as being indefinite. Applicants cannot agree and therefore traverse the rejection. As an initial matter, Applicants note that over 14,000 patents have been granted since 1976 in which the term "fixedly attached" has been used in the claims and that the Examiner has previously approved such language (See US 6,524,743). Moreover, from the discussion above, one of skilled in the art after reviewing the specification would clearly understand that the present claims particularly point out and distinctly claim the subject matter of the invention. Therefore, the rejection should be withdrawn.

The Examiner also rejected claim 38 under 35 USC 112 on the grounds that the phrase "non-removably attached" does not find basis or support in the originally filed disclosure. Applicants respectfully traverse this rejection.

As an initial matter, MPEP 2163 requires the Examiner to provide "reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed". The Office Action does not comply with this requirement.

Instead, the Office Action merely provides a conclusory statement that the claim fails to comply with the written description.

The specification clearly provides the necessary support for the term. Paragraph [0043] points out that Figs. 9 through 14 show various manufacturing methods for non-removably attaching an elastic bumper to the corresponding plastic housing. Paragraph [0044] describes that the elastic bumper may be over-molded onto the plastic housing. Paragraph [0045] describes an elastic bumper that is bonded to a plastic housing such that an interface of the bumper and plastic housing is completely melted together. Paragraph [0049] describes an elastic bumper that may be formed from a liquid elastomeric material in which the plastic housing is dipped such that the plastic housing receives a layer of rubber material that either melts with or cures to an interface with the plastic housing. Each of these methods necessarily results in an elastic bumper that is non-removably attached to the housing.

MPEP 1302.01 also cautions that "exact terms need not be used *in haec verba* to satisfy the written description requirement of the first paragraph of 35 U.S.C. 112". *Eiselstein v. Frank*, 52 F.3d 1035, 1038, 34 USPQ2d 1467, 1470 (Fed. Cir. 1995); *In re Wertheim*, 541 F.2d 257, 265, 191 USPQ 90, 98 (CCPA 1976). See also 37 CFR 1.121(e) which merely requires *substantial* correspondence between the language of the claims and the language of the specification. One skilled in the art would understand that the above provides complete written description support for the phrase "non-removably attached". Therefore, the rejection should be withdrawn.

Claims 1-16, 18-20, 23, 26-35 and 38 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. 5,401,591 to Bishay et al. (Bishay) in view of U.S. 6,376,126 to Faust et al. (Faust).

The Examiner makes note that the Applicant allegedly did not address the "argument by the examiner re the obviousness of bonding two members together where the two members comprise the elastic member and the battery pack". Applicants cannot agree. In short, one of skill in the art would not have bonded the two members together by adhesive or other bonding method because doing such would render the tool of Bishay impractical. If the elastic member was bonded to the battery pack by adhesive or other bonding method, then when the batteries (116) become completely discharged, the housings 108A and 108B forming the battery case 108 could not be separated so that the batteries could be replaced. As a result, Bishay teaches away from such a construction and simply requires that the boot be removable (see col. 436-42).

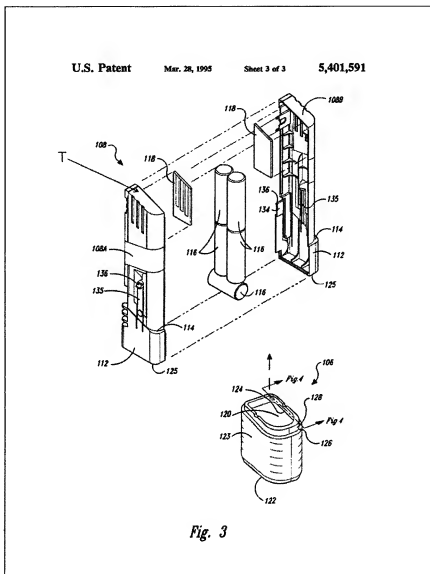
Faust does not cure this deficiency and, in fact, it cannot cure this deficiency since it is imperative to the operation of Bishay that the boot be removable. Accordingly, neither Bishay nor Faust, alone or in combination teach or suggest the presently claimed battery pack having a bumper fixedly attached to the plastic housing. The rejection should therefore be withdrawn.

Claims 21, 22, 24, 25, 36, 37 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Bishay and Faust in view of U.S. 5,553,675 to Pitzen et al. (Pitzen). Applicants cannot agree. The Examiner states that "to have included in the Bishay power tool/battery pack, the tapered guideway with connectors as shown in Pitzen

would have been obvious for the ease of securement of the battery pack onto the power tool and thus providing power to the power tool via the electrical connectors".

Even assuming that one skilled in the art would have modified Bishay in the manner suggested by the Examiner, such a modification still would not have taught each of the elements required by the claims. Claim 21 requires the cap of the battery housing (which necessarily must be opposite the floor) to be provided with a tapered guide-way such that the guide-way receives a flange on the power tool when the power tool is moved relative to the battery pack along a longitudinal axis generally parallel to the floor of the battery pack. In other words, modifying Bishay in the manner suggested by the Examiner would require providing guide-ways on the surface indicated as T in the attached figure taken from Bishay.

U.S. Patent Mar. 28, 1995 Sheet 3 of 3 5,401,591



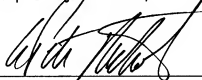
If such guide-ways were provided, the battery pack of Bishay would still not operate in the manner required by the claim because if the power tool of Bishay were to be moved relative to the battery pack along the longitudinal axis that is generally parallel to the floor of the battery pack, then the battery pack of Bishay would never be inserted into the handle of the tool of Bishay. In short, the proposed modification would render Bishay inoperable. Accordingly, the proposed modification cannot and does not render these claims obvious.

As shown in Fig. 2 of Bishay the battery pack engages the power tool when the power tool is moved relative to the battery pack along an axis that is generally perpendicular to the floor of the battery pack. Thus, providing a guide-way on the surface identified as T as shown above, still cannot teach each of the limitations required by the claims.

Moreover, the rationale the Examiner provides to modify Bishay, "for the ease of securement of the battery pack onto the power tool", is merely a statement without any factual support. In fact, Bishay already provides a means for ease of securement of the battery pack onto the power tool and thus one of skill in the art would not need to look to Pitzen or even have a desire to look to Pitzen to modify Bishay. Consequently, the proposed combination of Bishay and Pitzen – which Applicants contend is not proper – simply does not teach or suggest the proposed structure of the rejected claims. Therefore, the rejection should be withdrawn.

If, for any reason, the Examiner feels that the above amendments and remarks do not put the claims in condition for allowance, the undersigned attorney can be reached at (312) 321-4276 to resolve any remaining issues.

Respectfully submitted,



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